

REMARKS

The non-final Office Action mailed July 29, 2004, has been reviewed and carefully considered. Claims 1-29 are pending in the application. Claims 1-29 are rejected.

In paragraph two on page two of the Office Action, claims 1, 15, 18, 20, 24 and 25 were rejected under § 112, first paragraph. Claims 2-14, 16, 17, 19, 21-23, and 26-29 are rejected based on their dependency on the rejected independent claims.

In paragraph three on page three of the Office Action, claim 19 was rejected under § 112, first paragraph.

Applicant respectfully traverses the § 112, first paragraph rejection. The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. Moreover, Applicant asserts that the Office Action is incorrect in its assertion that “this residual print engine is stated to print all the unidentifiable jobs placed in the residual queue.” Rather, the print engine prints print jobs, including those print jobs forwarded to the residual print queue. In support of this assertion, Applicant points to the specification language, “[t]he present invention allows print jobs to be processed by a print server when using such protocols, even if the queue name provided as part of the command does not conform to any of the queue names currently identified on the print server,” at page 13, lines 14-18.

Furthermore, Applicant asserts that based upon the specification, at least as recited above, no undue or unreasonable experimentation is needed to practice the invention. In fact, Applicant asserts that the functions of a print server are well understood and, once one skilled in the art is provided with the teaching of the specification and the claims, how a print server accesses a residual print queue requires very little, if any, experimentation. Therefore, Applicant asserts that “printing a print job forwarded to the residual print queue” and “a print engine to print one or more of the print jobs in the residual print queue” are methods and systems that are understood by persons of ordinary skill in the art.

In paragraph four on page three of the Office Action, claims 1-7, and 9-29 were rejected under § 103(a) as being unpatentable over Hower, Jr. et al. (US 5,467,434) in view of Yellepeddy et al. (US 6,288,790).

In paragraph five on page 11 of the Office Action, Claim 8 is rejected under § 103(a) as being unpatentable over Hower in view of Yellepeddy as applied to independent Claim 1 and dependent Claim 7 above, and further in view of McLaughlin.

Applicants respectfully traverse the 35 U.S.C. § 103(a) rejections. Applicants respectfully assert that the cited references, alone or in combination, fail to teach, disclose or suggest all the claim limitations of Applicants' application.

The instant application includes a method for processing print jobs on a printing device having at least one named print queue and a residual print queue. The method requires at least "receiving print jobs; forwarding print jobs having a print queue designation that matches a named print queue in the printing device to the designated print queue; forwarding print jobs having a print queue designation that does not match a named print queue in the printing device to the residual print queue; and printing a print job forwarded to the residual print queue." Applicant's application does not rely on matching print job parameters with printer capabilities. Rather, Applicant's invention focuses on the print job's print queue designation and named print queues.

Hower, on the other hand, teaches that print queues are provided for selection by the user and each print queue is mapped to one of configuration files or printer profiles. Each of the printer profiles includes a list of printer properties, and are arranged to describe the combinations of print job selections available at a selected one of the printers. *See* column 4, lines 28-40. Rather than merely forwarding print jobs having print queue designations to named print queues, Hower matches print jobs with printer profiles, and designates the print jobs to printers accordingly.

Hower, does not disclose, teach or suggest the mere "forwarding print jobs having a print queue designation that matches a *named* print queue in the printing device to the designated print queue," because Hower matches printer parameters with parameters' of print jobs and then designates the printer for the print job, if a printer is available.

Furthermore, as the Office Action submits, Hower fails to disclose, teach or suggest "forwarding print jobs having a print queue designation that does not match a named print queue in the printing device to the residual print queue."

Yellepeddy fails to remedy the above-mentioned deficiency of Hower. According to Yellepeddy, when a client data processing system is disconnected from a desired remote print server, or the remote print server is otherwise inaccessible, a local transient printer queue is automatically created and all print jobs submitted by the client data processing system are spooled to the transient printer queue. In Yellepeddy, the transient print queue receives print jobs having designations matching a print queue that is disconnected or otherwise unavailable.

Accordingly, Yellepeddy fails to disclose, teach or suggest ““forwarding print jobs having a print queue designation that does not match a named print queue in the printing device to the residual pint queue.”

Furthermore, according to MPEP § 2143.01, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” When a user selects an impermissible combination of print selections that have not been programmed in Hower, a fault message is communicated to the user. *See* column 7, lines 37-41. Hower discloses that a decision tree is used to compare parameters of printers to print job selections and matching printers with print jobs, but when a print job requires unprogrammed print properties, none of the available printers are capable of printing the print job. *See* column 7.

Yellepeddy creates a transient print queue for holding print jobs assigned to a printer facility when the printer facility is unavailable, and holds the print job until the printer facility or another appropriate printer facility becomes available. *See* column 4, lines 11-16. Yellepeddy assumes that print jobs in the transient print queue are capable of being printed by a printer facility in the network. This is in contrast to Hower, where due to the nature of print job parameters associated with a print job, the print job is not capable of being printed by any printer. Thus, combining Yellepeddy with Hower would require the decision tree of Hower to be changed, thereby changing the principle of operation of Hower.

Accordingly, Hower and Yellepeddy alone or in combination, fail to disclose, teach or suggest all of the limitations of Applicants’ application. Furthermore, the proposed modification to Hower in view of Yellepeddy would change the principle of operation in Hower. Thus,

Applicants assert that the § 103(a) rejections are improper and request that the rejections be withdrawn.

Dependent claims 2-14, 16-17, 19, 21-23, and 26-29 are also patentable over the references, because they incorporate all of the limitations of the corresponding independent claims 1, 15, 18, 20 and 25. Further dependent claims 2-14, 16-17, 19, 21-23, and 26-29 recite additional novel elements and limitations. Applicants reserve the right to argue independently the patentability of these additional novel aspects. Therefore, Applicants respectfully submit that dependent claims 2-14, 16-17, 19, 21-23, and 26-29 are patentable over the cited references, and request that the objections to the independent claims be withdrawn.

On the basis of the above amendments and remarks, it is respectfully submitted that the claims are in immediate condition for allowance. Accordingly, reconsideration of this application and its allowance are requested.

If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Attorney for Applicants, David W. Lynch, at 651-686-6633 Ext. 116.

CRAWFORD MAUNU PLLC
1270 Northland Drive, Suite 390
Saint Paul, MN 55120
(651) 686-6633

Respectfully submitted,

By: 

Name: David W. Lynch

Reg. No.: 36,204